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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/664,482 | 09/17/2003 | Richard A. Tatina | P03,0313 | 4369 |

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EXAMINER

GORDON, STEPHEN T

ART UNIT PAPER NUMBER

3612

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/664,482 | Applicant(s) TATINA, RICHARD A. | |
| | Examiner Stephen Gordon | Art Unit 3612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9-17-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19 and 27, drawn to a container system, classified in class 410, subclass 68
 - II. Claims 20-26 and 28, drawn to a method of assembling for container transport, classified in class 410, subclass 68.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as one wherein the lower containers are raised to engage the upper containers.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation between attorney Brett Valiquet and examiner Eugene Lhymn on 10-17-05 a provisional election was made with traverse to prosecute the invention of group II, claims 20-26 and 28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-19 and 27 are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant should note, the application has been transferred to the current examiner in view of applicant's election (note current examiner is different than examiner noted above).

5. It is requested that applicant cancel non-elected claims 1-19 and 27 in response to this action to facilitate the issue process if the application is ultimately allowed.

6. Claims 20-26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20, the recited connectors on line 7 and bridging the last two lines are confusing as it is not clear if/how such connectors relate back to the previously recited connectors throughout the claim. The claim language should be amended to clarify such relationships. The recited at least one stabilizer on line 8 is confusing as it is not clear if/how such stabilizer relates back to the previously recited stabilizer of line 6. The claim language should be amended to clarify such relationship. The term "two adjacent inter-box connectors" on lines 8-9 is somewhat confusing and could be written as –two adjacent ones of said inter-box connectors—for clarity as best understood. In line 10, "the inter-box connectors" lacks clear antecedent basis and could be written as –the two adjacent inter-box connectors—for clarity as best understood. Line 11, "the respective two lower containers" lacks clear antecedent basis. Finally, "the upper and lower containers" of line 12 lacks clear antecedent basis.

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Claim 21, “the inter-box connectors” bridging lines 2 and 3, “the lower containers” on line 3, “the bottom container” (2 places total), and “the top container” (2 places total) lack clear antecedent basis. Additionally, “the connector” in line 4 is somewhat confusing and could be written as –the respective connector—for clarity as best understood.

Claim 22, “said container bridging stabilizers”, “each of the container bridging stabilizers”, and “the lower containers” lack clear antecedent basis. Additionally, the recited connectors on line 3 are confusing as it is not clear if/how they relate to the other previously recited connectors. The claim language should be amended to clarify such relationships.

Claim 23, “the two lower shipping containers” lacks clear antecedent basis.

Claim 24, the shipping containers are confusing as it is not clear if/how they relate to the other previously recited containers. The claim language should be amended to clarify such relationships.

Claim 25, “the lower containers”, “the container spreader tool” (note similar term in claim 26), “the two lower shipping containers”, and “the bridging stabilizer” lack clear antecedent basis.

Claim 26, “the adjacent lower containers” lacks clear antecedent basis. Additionally, “numbers” is confusing and should apparently be –members--.

Claim 28, the recited connectors on lines 7 and 8 are confusing as it is not clear if/how these connectors relate to the previously recited connector(s). the claim language should be amended to clarify such relationships. Finally, “the connectors” in line 9, “the

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respective two lower containers”, “the upper and lower containers”, and “the connectors” in the last line lack clear antecedent basis.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 20, 22, and 28, as best understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morris et al '714.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23-24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al '714.

Regarding claim 23, Morris et al teaches all of the claimed features but fails to specifically teach that the transport can be a well car. Well cars per se are notoriously well known forms of transport vehicle for containers in the art. Specific recitation of the transport as defining a well car then would not in this case define a patentably distinct departure from the teachings of Morris et al.

Regarding claim 24, Morris et al teaches all of the claimed features but fails to specifically teach that the containers define 20' containers. 20' containers per se are notoriously well known as a common form of load bearer in the art. Specific recitation of

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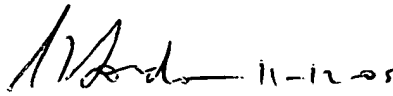
the containers as defining 20' containers then would not in this case define a patentably distinct departure from the teachings of Morris et al.

11. Claims 21 and 25-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gordon whose telephone number is (571) 272-6661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen Gordon
Primary Examiner
Art Unit 3612

stg